

**REMARKS**

Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 are pending in the present application. Reconsideration of the claims is respectfully requested.

**I. 35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 under 35 U.S.C. § 103 as being unpatentable over Shkedy (U.S. Pat. No. 6,260,024) in view of Hoyt et al. (U.S. Pat. No. 6,067,531). This rejection is respectfully traversed.

With respect to Claim 1 (and dependent Claims 2-6), Applicants show that none of the cited references teach or suggest the claimed feature of "storing at least one terms and conditions set *containing parameters corresponding to selected rules from the compilation of business rules*". In rejecting Claim 1, the Examiner alleges that the cited Shkedy reference teaches "storing set containing parameters (see., abstract, figs 2 and 3, col. 2, lines 1-9, col. 5, lines 32-67)". Applicants show that this merely alleges a teaching of storing a set containing parameters. The Examiner has not alleged, nor do the references actually teach or suggest, any type of correspondence between these parameters and selected rules from the compilation of business rules. The passage cited by the Examiner at Shkedy Col. 2, lines 1-9 merely describes how a buyer creates a conditional purchase offer by selecting an item they wish to purchase, adds any conditions they wish to place on the purchase and specifies a price at which they will purchase. This conditional purchase offer is then transmitted to a central computer, where it can be searched by potential sellers. The passage cited by the Examiner at Shkedy Col. 5, lines 32-67 expands upon this buyer/seller co-action and further states that the central controller transmits a price back to the buyer, and this central controller may also add legal language to the purchase order sent to the buyer. The buyer can then either accept or reject this purchase order. Notably absent is any discussion pertaining to parameters that are associated to selected rules from the compilation of business rules. This is likely because the cited reference does not teach or suggest BOTH a compilation of business rules AND a terms and conditions set having parameters, so there is no way to have parameters of the terms and conditions set that are associated with the business rules, as claimed. This claimed feature advantageously provides an ability for logic

associated with the business rules to use execution parameters. For example, if the business rules contains logic to determine a discounted price, the corresponding terms and conditions instance in the terms and conditions set would set the discount percentage (Specification page 16, lines 4-7).

Further with respect to Claim 1 (and dependent Claims 2-5), Applicants show that none of the cited references teach or suggest the claimed feature of “generating links *between the compilation of business rules and the terms and conditions set* to generate specific terms and conditions to be embodied in the contract”. This claimed feature allows for generation of specific terms and conditions, using the business rules, thus advantageously providing a hierarchical relationship where business rules for an entire business can be defined/described in the business rules, which can then be customized to generate specific terms and conditions for a contract (Specification page 16, lines 8-11; FIG. 3). In rejecting this claimed step, the Examiner cites Shkedy Col. 5, lines 7-60 and Shkedy FIG. 5 as teaching “generating links between the contract”. Applicants show that Claim 1 does not merely recited generating links between the contract (Applicants are also unclear how links can be generated *between* a single item such as a contract), but rather recites that these links are between (i) the compilation of business rules, and (ii) the terms and conditions set. Thus, the links are between multiple recited items. A mere assertion of links between a single contract does not establish links between multiple items, and specifically does not establish a teaching or suggestion of links between business rules and a terms and conditions set. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 1<sup>1</sup>. As a prima facie case of obviousness has not been established, the burden has not shifted to Applicants to rebut an

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<sup>1</sup> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

obviousness assertion with respect to Claim 1<sup>2</sup>. In addition, since a prima facie case of obviousness has not been made, the rejection of Claim 1 is improper<sup>3</sup>.

It should also be noted that the passage cited by the Examiner does not actually generate or create a contract, and thus contrary to the Examiner's assertion, does not teach or suggest generating links between the contract, as alleged. Rather, this cited passage merely states that after an exchange between a buyer and intermediary, the buyer *has consented to entering into a legally binding contract* with the intermediary and will accept the best price. Using terms/words such as 'consenting to enter into' a contract, and 'will accept' the best price are with respect to future actions on the part of the buyer, and no contract is generated by the teachings of Shkedy at Col. 5, lines 7-60. As there is no contract, there can not be links between such (non-existent) contract.

Further with respect to Claim 1, there is no teaching or suggestion of the claimed step of "interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract". In rejecting this step of Claim 1, the Examiner merely alleges that the cited Shkedy reference teaches 'interlocking the links to lock the contract (see., col 7, lines 26-42)". Applicants show multiple errors in such assertion with respect to Claim 1, as follows.

First, as shown above, the cited reference does not teach or suggest the claimed "links" between the business rules and terms and conditions, so it therefore cannot teach or suggest an interlocking step which uses such (non-existent) links. Secondly, a mere assertion of a teaching of "interlocking the links to lock the contract" does not establish a teaching or suggestion of interlocking (i) the compilation of business rules, (ii) the terms and conditions set *and* (iii) the links to lock the contract, as claimed in Claim 1. Thus, the Examiner is further shown to have failed to establish a prima facie showing of obviousness with respect to Claim 1, as there are missing claimed features not alleged to be taught or suggested by the cited references. Thirdly, it is urged by Applicants that the

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<sup>2</sup> Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *In re Oetiker*, supra.

<sup>3</sup> If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

passage cited by the Examiner as teaching interlocking the links to lock the contract provides no such teaching. At Col. 7, lines 26-42, Shkedy states:

“In another embodiment of the present invention, the intermediary could pre-negotiate a supply contract with a major supplier, prior to forming the buyer pool. Prospective buyers could view the pre-negotiated contract as a criterion for deciding whether or not they wish to participate in the pool. The pre-negotiated seller contract terms would be automatically available to any individual who joins the pool. In this embodiment, the intermediary pre-negotiates a contract with a seller such as an office supply company whereby the terms of the contract specify that the office supply company would beat any published competitors price and provide an additional 5% discount to the collective buyer pool on condition that the intermediary (i.e. collective buyer pool) exclusively purchase supplies from them for a whole year. Under this scenario, the pool is unconditionally guaranteed an up-front cost savings”.

As can be seen by a careful reading of this passage, there is a mere mention of a pre-negotiated contract. There is no mention that this contract is locked, and similarly there is no mention of interlocking links to lock a contract, as alleged by the Examiner. Thus, Claim 1 is still further shown to have been erroneously rejected by the Examiner as there are still further missing claimed elements not taught or suggested by the cited references.

Further with respect to Claim 2 (and dependent Claims 3-5), Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed feature of “the computer further stores at least one product list filter for generating a list of a specified subset of products from a master list of products, and generates links between the product list filter, the terms and conditions set and the master list of products”. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 2 (and dependent Claims 3-5), the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim

2 (and dependent Claims 3-5) is thus improper as a prima facie case of obviousness has not been made.

Further with respect to Claim 3, Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed feature of "the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products". Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 3, the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim 3 is thus improper as a prima facie case of obviousness has not been made.

Further with respect to Claim 4, Applicants show that none of the cited references teach or suggest "the contract comprises dynamic elements which can be unilaterally altered by either the seller or the buyer". Curiously, the Examiner cites an identical passage of Shkedy (Col. 7, lines 26-42) as teaching an ability to lock a contract (in rejecting Claim 1) as well as an ability of the contract to be unilaterally altered (in rejecting Claim 4). It is unclear how an alleged teaching of locking a contract can also be a teaching of unilaterally altering a (locked) contract. Applicants request further clarification regarding the basis for rejection of Claim 4.

Further with respect to Claim 5, Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed feature of "the product list filter is a dynamic element". Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 5, the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim 5 is thus improper as a prima facie case of obviousness has not been made.

Further with respect to Claim 6, Applicants show that none of the cited references teach or suggest the claimed feature of "the contract is locked by the implementation of digital signatures". In rejecting Claim 6, the Examiner states that this feature is disclosed by Shkedy figs 2, 12 and 14, specifically signature keys, col 47-67. Applicants first show that the cited reference does not have cols 47-67 (the patent ends at col. 32). As to the assertion with respect to Shkedy Figs 2, 12 and 14, while figure 14 does show use of a key, the key is not used to lock a contract, as claimed. Rather, this Shkedy key is used in conjunction with cryptographic techniques to authenticate the seller's bid (Shkedy Col.

22, lines 47-60). A teaching of bid authentication does not teach or suggest locking of a contract for at least two reasons. First, a bid is not a contract (but rather a mere offer to enter into a contract), and secondly authentication does not provide any type of locking. Thus, Claim 6 is further shown to have been erroneously rejected as there is missing claimed feature not taught or suggested by the cited references.

Applicants traverse the rejection of Claim 7 (and dependent Claims 8-13) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 8 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 9 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 10 for further reasons given above regarding Claim 4.

Applicants further traverse the rejection of Claim 11 for further reasons given above regarding Claim 5.

Applicants further traverse the rejection of Claim 12 for further reasons given above regarding Claim 6.

Further with respect to Claim 13, Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed feature of "The method as defined in claim 7 including, between steps c. and d., the step of communicating the contract to the seller or to the buyer for amendment or approval". Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 13, the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim 13 is thus improper as a prima facie case of obviousness has not been made.

With respect to Claim 14 (and dependent Claim 16), Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, any type of post-contract processing. Specifically, there is no teaching or suggestion, or alleged teaching or suggestion, of "A system for *conducting a contractual activity* over a computer network *pursuant to a contract* between at least one seller and at least one buyer, the contract comprising a predefined set of terms and conditions". In

addition, Applicants show that none of the cited references teach or suggest, nor has the Examiner alleged any teaching or suggestion of, the claimed features of “wherein the communications interface *displays selected information based on terms and conditions in the contract*”, or a computer for receiving the information and *referencing the terms and conditions of the contract to process the information*. Thus, the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 14 (and dependent Claim 16), the burden has not shifted to Applicants to rebut an obviousness assertion, and the rejection of Claim 14 (and dependent Claim 16) is thus improper as a prima facie case of obviousness has not been made.

Applicants traverse the rejection of Claim 17 (and dependent Claim 19) for similar reasons to those given above regarding Claim 14.

Applicants traverse the rejection of Claim 20 (and dependent Claims 21-26) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 21 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 22 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 23 for further reasons given above regarding Claim 4.

Applicants further traverse the rejection of Claim 24 for further reasons given above regarding Claim 5.

Applicants further traverse the rejection of Claim 25 for further reasons given above regarding Claim 6.

Applicants further traverse the rejection of Claim 26 for further reasons given above regarding Claim 13.

Applicants traverse the rejection of Claim 27 (and dependent Claim 29) for similar reasons to those given above regarding Claim 14.

Applicants traverse the rejection of Claim 30 (and dependent Claims 31-35) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 31 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 32 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 33 for further reasons given above regarding Claim 4.

Applicants further traverse the rejection of Claim 34 for further reasons given above regarding Claim 5.

Applicants further traverse the rejection of Claim 35 for further reasons given above regarding Claim 6.

Applicants traverse the rejection of Claim 36 (and dependent Claim 38) for similar reasons to those given above regarding Claim 14.

Applicants traverse the rejection of Claim 39 (and dependent Claims 40-45) for similar reasons to those given above regarding Claim 1.

Applicants further traverse the rejection of Claim 40 for further reasons given above regarding Claim 2.

Applicants further traverse the rejection of Claim 41 for further reasons given above regarding Claim 3.

Applicants further traverse the rejection of Claim 42 for further reasons given above regarding Claim 4.

Applicants further traverse the rejection of Claim 43 for further reasons given above regarding Claim 5.

Applicants further traverse the rejection of Claim 44 for further reasons given above regarding Claim 6.

Applicants further traverse the rejection of Claim 45 for further reasons given above regarding Claim 13.

Applicants traverse the rejection of Claim 46 (and dependent Claim 48) for similar reasons to those given above regarding Claim 14.

Therefore, the rejection of Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 under 35 U.S.C. § 103 has been overcome.

**II. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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